



06 SEP 2005

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In re Application of
Shuster, et al.
Serial No.: 10/500,499
PCT No.: PCT/US02/41850
Int. Filing Date: 31 December 2002
Priority Date: 31 December 2001
Attorney's Docket No.: 14848-007US1
For: METHODS AND MATERIAL FOR
MODULATING ENAC-BETA

DECISION ON
PETITION
UNDER 37 CFR 1.47(a)

This decision is responsive to the "RENEWED PETITION UNDER 37 C.F.R. 1.47(a)"
filed 17 May 2005.

BACKGROUND

On 31 December 2002, applicants filed international application PCT/US02/41850, which claimed priority of an earlier United States provisional application filed 31 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 17 July 2003. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 30 June 2004.

On 29 June 2004, applicants filed a transmittal letter for entry into the national stage in the United States. The transmittal letter was accompanied by, *inter alia*, the basic national fee and an assertion of small entity status. These papers were assigned Application No. 10/500,499.

On 26 August 2004, the United States Patent and Trademark mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration and a copy of the sequence listing in both paper and computer readable form and an amendment directing its entry into the specification. The notification set a two-month time period in which to respond.

On 03 January 2004, applicant filed a petition under 37 CFR 1.47(a) requesting that the application be accepted without the signature of Ulf N.G. Arvidsson. The petition was accompanied by several declarations of inventors, the surcharge for filing the declarations after thirty months from the priority date, a petition/fee for a two-month extension of time and a declaration of M. Angela Parsons.

On 16 February 2005, a decision was mailed to applicant indicating that the petition was dismissed because it was not clear that M. Angela Parsons had first hand knowledge of the facts. Also, it was not clear whether applicant was alleging that inventor Arvidsson could not be found or was refusing to sign. Further, it was not clear that inventor Arvidsson had ever been sent a copy of the application.

On 17 May 2005, applicant filed a renewed petition.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing inventor. The petition is missing item (2) above.

Applicant satisfied the requirements of (1), (3) and (4) in the earlier filed petition.

With respect to element (2), it is still not clear that inventor Arvidsson is no longer at his last known address. According to Ms. Parson's declaration, someone at that address did sign for a letter addressed to inventor Arvidsson. Applicant is reminded that the non-signing inventor must be presented with a copy of the entire application, and not just a copy of the declaration.

CONCLUSION

The petition under 35 U.S.C. 1.47(a) is **DISMISSED without prejudice**.

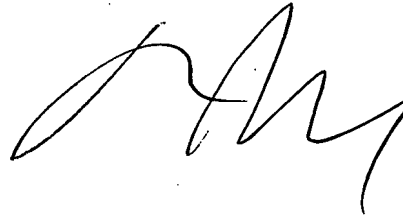
If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely submit the proper response will result in **ABANDONMENT**. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Should status under 37 CFR 1.47(a) not be successfully completed, the international application will be viewed as becoming abandoned with respect to the United State at midnight at the expiration of the time period set in this decision or as extended by any extension see timely paid under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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